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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,913	12/10/2003	David A. Fell	659/1715 KC 19441	6819
757 7590 09/27/2007 BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER BOGART, MICHAEL G	
			ART UNIT 3761	PAPER NUMBER
			MAIL DATE 09/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/732,913

Applicant(s)

FELL ET AL.

Examiner

Michael G. Bogart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 10-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mason, Jr. *et al.* (US 4,886,513; hereinafter "Mason") in view of Lee *et al.* (US 6,015,934 A; hereinafter "Lee").

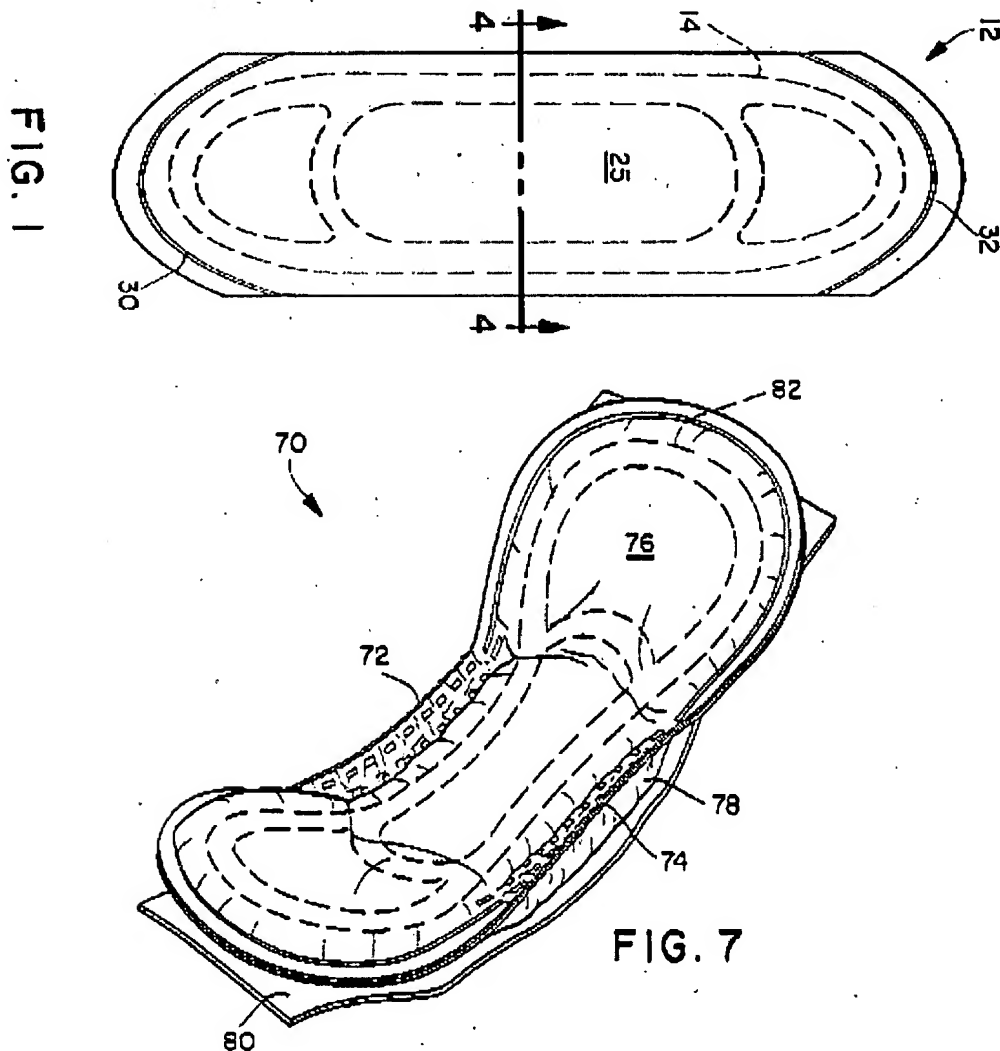
Regarding claims 10-12, Mason teaches an absorbent article (12) that resists permanent creasing comprising:

an absorbent core (20) comprising an activation layer (14) and at least first and second opposite longitudinal end portions each defining a body side surface, wherein said absorbent

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article (12) is independently movable from a folded condition, wherein said body side surfaces of said first and second portions face will each other in a substantially parallel relationship under a sufficient applied pressure applied to said first and second portions, to an unfolded condition, wherein no pressure is applied to said first and second portions;

wherein said body-side surfaces of said first and second portions form at least one angle greater than or equal to about 90° to 130° in said unfolded condition (abstract)(see figures 1 and 7, infra).



Mason is silent as to the article performance vectors which are functional limitations. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). MPEP § 2114.

Optimization of ranges of performance vectors or intrinsic properties will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such performance vector is critical. MPEP § 2114.05.

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)

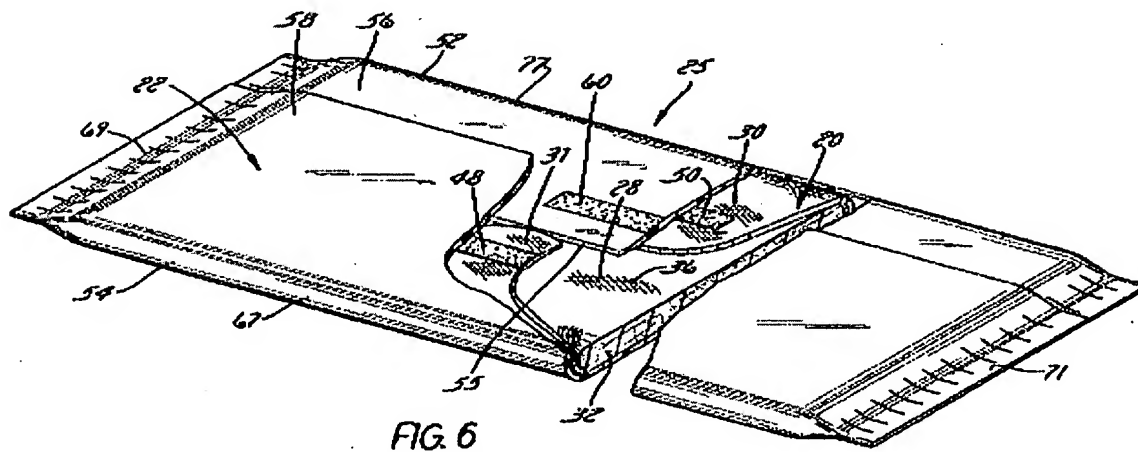
In the case of the device of Mason, making the resilient material such that it is increasingly able resist compressive force so that it can readily spring back into shape after deformation would come at the expense of wearer comfort as it would exert this resilience against a wearer and their garments. Conversely, reducing the spring recovery ability excessively by making it too willowy would result in an article that lacked adequate spring recovery (a willowy material such as conventional cloth would have minimal spring recovery but would resist permanent folding).

Mason does not expressly disclose a packaging component.

Lee teaches a sanitary napkin (20) with a packaging component (22)(see fig. 6, *infra*).

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At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the packaging component of Lee to wrap the absorbent article of Mason in order to render it convenient for a wearer to transport in a pocket or purse.



Regarding claim 13, Mason teaches a third longitudinally central crotch portion located between the longitudinal end portions.

Claims 10-13 are rejected under 35 U.S.C. § 103(a) as obvious over Rainville-Lonn *et al.* (US 2003/0114805 A1; hereinafter "Rainville-Lonn") in view of Lee.

Regarding claims 10-12, Rainville-Lonn teaches an absorbent article (10) that resists permanent creasing comprising:

an absorbent core comprising an activation layer (14) and at least first and second opposite longitudinal end portions each defining a body side surface, wherein said absorbent article (10) is independently movable from a folded condition, wherein said body side surfaces of said first and second portions face will each other in a substantially parallel relationship under a

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sufficient applied pressure applied to said first and second portions, to an unfolded condition, wherein no pressure is applied to said first and second portions;

wherein said body-side surfaces of said first and second portions form at least one angle greater than or equal to about 90° to 130° in an unfolded condition (abstract)(see figures 1 and 2, *infra*).

Rainville-Lonn is silent as to the article performance vectors which are functional limitations. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). MPEP § 2114.

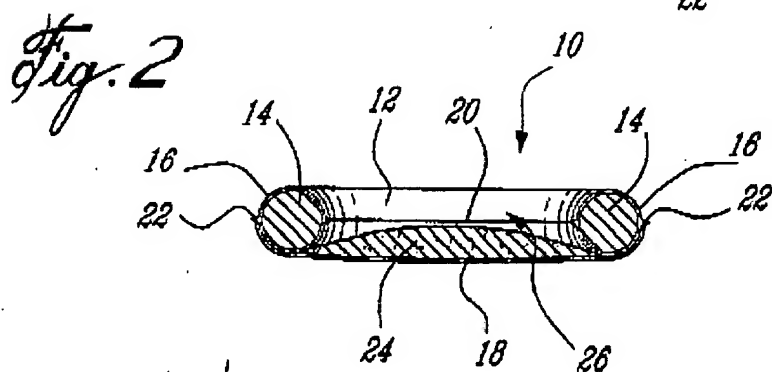
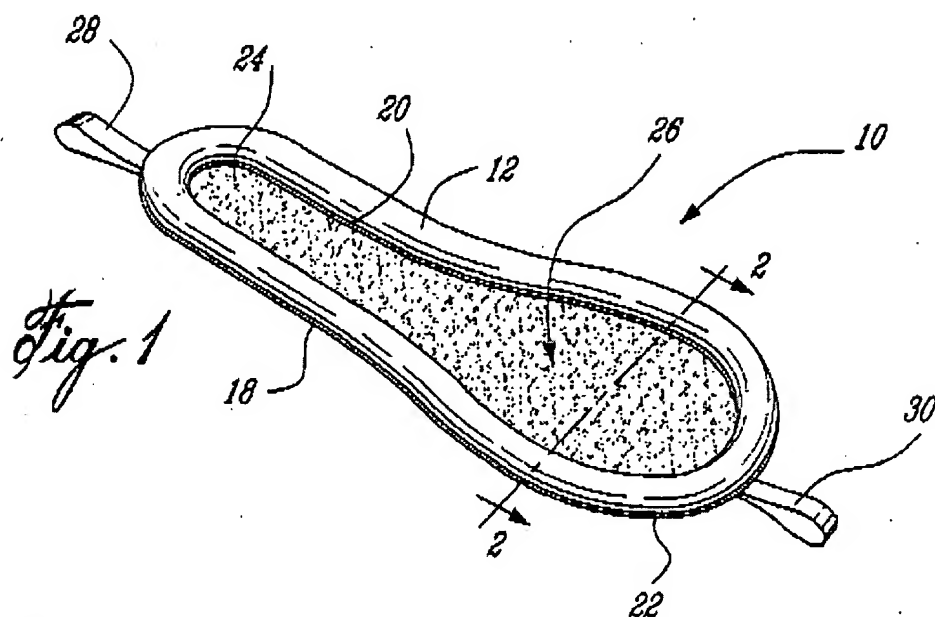
Optimization of ranges of performance vectors or intrinsic properties will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such performance vector is critical. MPEP § 2114.05.

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)

In the case of the device of Rainville-Lonn, making the springy such that it is increasingly able resist compressive force so that it can readily spring back into shape after deformation would come at the expense of wearer comfort as it would exert this resilience against a wearer and their garments. Conversely, reducing the spring recovery ability excessively by making it too willowy would result in an article that lacked adequate spring

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recovery (a willowy material such as conventional cloth would have minimal spring recovery but would resist permanent folding).



Rainville-Lonn does not expressly disclose a packaging component.

Lee teaches a sanitary napkin (20) with a packaging component (22)(see fig. 6, supra).

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At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the packaging component of Lee to wrap the absorbent article of Rainville-Lonn in order to render it convenient for a wearer to transport in a pocket or purse.

Regarding claim 13, Rainville-Lonn teaches a third portion central crotch portion located between the longitudinal end portions.

Claims 14 and 16-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainville-Lonn and Lee as applied to claims 10-13 above, and further in view of Mason.

Rainville-Lonn and Lee teach a foam layer (14) over a highly absorbent layer (24), but does not expressly teach the use of a superabsorbent (§ 0019).

Mason teaches the use of a superabsorbent to enhance absorbency (col. 6, lines 50-65).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the superabsorbent layer of Mason in the resilient sanitary napkin of Rainville-Lonn and Lee in order to provide enhanced absorbency.

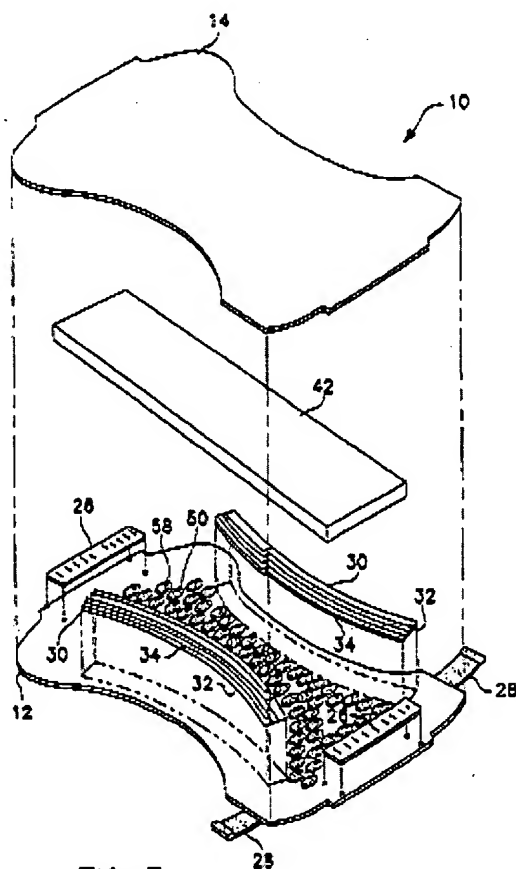
Regarding claims 14 and 16-21, the references do not teach the specific caliper of the article.

Mere changes in size are not sufficient to patentably distinguish an invention over the prior art. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Claims 15 and 22-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainville-Lonn, Lee and Mason as applied to claims 14 and 16-21 above, and further in view of Tanzer *et al.* (US 6,429,350 B1; hereinafter "Tanzer").

Rainville-Lonn, Mason and Lee do not expressly disclose an absorbent open-celled foam layer over a superabsorbent layer.

Tanzer teaches an absorbent containing open cell foam layer (42) over a superabsorbent layer (58). This construction eliminates the need for redundant layers of material, allowing the final absorbent article to have a thin caliper (col. 6, lines 14-53)(fig. 3).



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At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the foam and superabsorbent layer construction of Tanzer in the sanitary napkin of Rainville-Lonn, Mason and Lee in order to provide a thin caliper.

Response to Arguments

Applicant's arguments filed 02 July 2007 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 10-24 have been considered but are moot in view of the new ground(s) of rejection. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the activating member not being positioned only in the crotch region) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants assert that folding the device of Mason for insertion in a package may irreparably damage the activating member. This argument is not persuasive because Mason teaches that the activation member may be in some embodiments "willowy" (col. 5, lines 57-68).

Applicants assert that test data shows that the applied references do not inherently perform as claimed in the present invention. This argument is not persuasive because the rejections for inherency have been withdrawn. The new grounds of rejection are on the grounds that the claimed ranges of performance vectors are merely an optimization of what is known in the art.

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In response to applicant's argument that Tanzer does not teach or suggest the use of an activating member, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

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In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Bogart
17 September 2007